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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/659,448 | 09/11/2000 | Motohide Takeichi | Yanagihara Case 52 | 5818 |

7590 10/21/2002
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EXAMINER

GRAYBILL, DAVID E

| ART UNIT | PAPER NUMBER |
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2827

DATE MAILED: 10/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/659,448

Applicant(s)

TAKEICHI ET AL.

Examiner

David E Graybill

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 0715.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3 and 6-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3 and 6-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3, 6, 7 and 8-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Tomita (WO98/44067) (with reference to English translation equivalent EP0979854).

As cited in EP0979854, at paragraphs 0010, 0013, 0015, 0016, 0019, 0059-0062, 0071, 0074-0083, 0089, 0091, 0094, 0096, 0100, 0106-0108, 0120, 0124, 0126, 0127, 0135, 0136, 0140 and 0150, Tomita teaches all the essential elements of the claims.

To further clarify the teaching of the particular elastic modulus, it is noted that the teaching of Tomita of, "a modulus of elasticity of from 100 to 2,000 MPa, and more, preferably from 1,000 to 1,800 MPa, at 40°C after curing," anticipates the claimed modulus. Moreover, the particular claimed elastic modulus is an inherent property of the instant claimed product and the identical product of Tomita.

To further clarify the teaching of the particular claimed Tg, this limitation is an inherent property of the instant claimed product and the identical product of Tomita.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tomita as applied to claims 3, 6, 7 and 8-19, and further in combination with Yamada (JP407197001).

Tomita does not appear to explicitly teach wherein the COG assembly is a liquid crystal display.

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Nonetheless, in the English abstract and figures, Yamada teaches this product. Moreover, it would have been obvious to combine the product of Yamada with the product of Tomita because it would provide a COG assembly.

In the alternative, claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomita as applied to claims 18 and 19 supra, and further in combination with Satsu (20010053448).

Tomita does not appear to explicitly teach the particular claimed Tg.

Notwithstanding, at paragraphs 0005, 0016, 0020, 0024, 0049, 0060-0068 and 00127, and Table I, Satsu teaches the particular claimed Tg. In addition, it would have been obvious to combine the product of Satsu with the product of Tomita because it would minimize cracking.

Also, Tomita does not appear to explicitly teach the particular claimed elastic modulus.

However, as cited, Satsu teaches that elastic modulus is a result effective variable. Furthermore, it would have been an obvious matter of design choice bounded by well known manufacturing constraints and ascertainable by routine experimentation and optimization to choose the particular claimed elastic modulus limitation because applicant has not

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disclosed that the limitation is for a particular unobvious purpose, produces an unexpected result, or is otherwise critical, and it appears prima facie that the product would possess utility using another elastic modulus. Indeed, it has been held that optimization of range limitations are prima facie obvious absent a disclosure that the limitations are for a particular unobvious purpose, produce an unexpected result, or are otherwise critical. See MPEP 2144.05(II): "Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. '[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.'" In re Aller, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955). See also In re Hoeschele, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969), Merck & Co. Inc. v. Biocraft Laboratories Inc., 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989), and In re Kulling, 897 F.2d 1147, 14 USPQ2d 1056 (Fed. Cir. 1990). As set forth in MPEP 2144.05(III), "Applicant can rebut a prima facie case of obviousness based on overlapping ranges by showing the criticality of the claimed range. 'The law is replete with cases in which the difference between the

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claimed invention and the prior art is some range or other variable within the claims. . . . In such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range.' In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). See MPEP § 716.02 - § 716.02(g) for a discussion of criticality and unexpected results."

Applicant's amendment and remarks filed 7-15-2 have been fully considered, and are addressed in the rejection supra and are further addressed infra.

Applicant's argument that the definition of the non-art-recognized term, "tensile elongation percentage" as, "the percent that the tested sample stretches until the rupture point," is persuasive.

Also, applicant states, "on specification page 8, the third and fourth paragraphs explicitly describe the microparticulate elastomer used in the present invention." This citation appears to be incorrect because there is no such description at the cited location. However, the term "microparticulate elastomer" is recited at page 7, last two paragraphs. Further, the last two paragraphs of page 7 merely explicitly describe permissible [e.g. "may be"] microparticulate elastomer properties and

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materials, and do not explicitly define the term. As a result, it is respectfully submitted that applicant's assertion, "The Examiner clearly is in error in stating that the present disclosure does not define this term [microparticulate elastomer]," is in error.

Relatedly, applicant alleges that the definition of the term "microparticulate elastomer" is "self-explanatory," but applicant does not provide the allegedly self-explanatory definition. Therefore, for examination purposes, the term "microparticulate elastomer" is defined as a very small, separate quantity of elastic substance resembling rubber.

Applicant also contends that Tomita does not teach an adhesive comprising a microparticulate elastomer. This contention is respectfully traversed because, as cited, the English language translation of Tomita teaches this limitation, for example, at paragraph 0071, "The phase-separated structural product of the present invention . . . wherein . . . the elastomer phase and the phenoxy resin phase are disbursed in the form of very small particles."

Also, applicant alleges that Examples 1-4 have unexpected properties over Comparative Examples 1 and 2. This allegation is respectfully deemed to be unpersuasive because the prior art is not applied in the rejections for teachings of Examples 1-4

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or Comparative Examples 1 and 2. Moreover, unexpected properties cannot be relied on to overcome a rejection based on anticipation. Specifically, Tomita anticipates the instant claimed range; therefore, Tomita inherently teaches the alleged unexpected properties. Furthermore, applicant originally disclosed and presently discloses (see for example the abstract) and claimed an embodiment of the invention not limited to Examples 1-4. As indicated in MPEP 2164.089(c), "Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality." In any case, it is respectfully submitted that unexpected results must be established by factual evidence, and not by mere argument. See, for example, *In re De Blauwe*, 736 F.2d 699, 222 USPQ 191, 196 (Fed. Cir. 1984), and MPEP 716.02(d), "Demonstrating Criticality of a Claimed Range To establish unexpected results over a claimed range, applicants should compare a sufficient number of tests both inside and outside the claimed range to show the criticality of the claimed range. In *re Hill*, 284 F.2d 955, 128 USPQ 197 (CCPA 1960). To this end, the arguments of counsel cannot take the place of evidence in the record. In *re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Instead, the evidence relied on should establish "that the differences in results are in fact unexpected and

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unobvious and of both statistical and practical significance." Ex parte Gelles, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). See also, Ex parte C, 27 USPQ2d 1492 (Bd. Pat. App. & Inter. 1992); In re Nolan, 553 F.2d 1261, 193 USPQ 641, 645 (CCPA 1977); and In re Eli Lilly, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990).

The art made of record and not applied to the rejection is considered pertinent to applicant's disclosure. It is cited primarily to show inventions similar to the instant invention.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

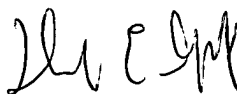
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any telephone inquiry of a general nature or relating to the status (MPEP 203.08) of this application or proceeding should be directed to Group 2800 Customer Service whose telephone number is 703-306-3329.

Any telephone inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Graybill at (703) 308-2947. Regular office hours: Monday through Friday, 8:30 a.m. to 6:00 p.m.

The fax phone number for group 2800 is 703/308-7722.



David E. Graybill
Primary Examiner
Art Unit 2827

D.G.
16-Oct-02